

Remarks

Claims 1-10 of the present application were indicated to be allowable in Office Action dated March 12, 2004. Applicant filed a Request for Continued Examination ("RCE") on June 14, 2004 introducing new claims 11-32. In a restriction requirement dated September 1, 2004, the Examiner invited applicant to elect between Group I (claims 1-10), Group II (claims 11-26, 30-32) and Group III (claims 27-29). Applicant previously elected Group II in a response dated October 1, 2004. Rejections as to Group II claims were presented in an Office Action dated November 2, 2004 to which the applicant now responds.

Applicant has reviewed the prosecution of the present application in connection with the provisions of MPEP §819, MPEP §821.03, and MPEP §819.01. Under MPEP §819 and MPEP §821.03, an applicant may not as a matter of right file a Request for Continued Examination ("RCE") in order to obtain continued examination for claims indicated to be independent and distinct from previous claims. Accordingly, unless the Examiner states otherwise, applicant will conclude that by inviting the applicant to select between Groups I, II, and III the Examiner has proceeded under MPEP §819.01. Under MPEP §819.01, the Office may permit a shift from claiming one invention to claiming another.

Claims 11-26 and 30-32 stand rejected under 35 USC §103(a) as being obvious over U. S. Patent No. 6,283,375 to Wilz., Sr. et al. ("Wilz"). Claims 1-10, 27-29 are cancelled without prejudice or disclaimer as being directed to an unelected invitation.

Briefly, independent claim 11 recites a portable device which among other elements includes an imaging assembly and a control circuit wherein the control circuit is configured to operate in a mode in which the control circuit sends to a spaced apart device an image along with a set of instructions instructing the spaced apart device to (a) decode a bar code symbol represented in said image to generate a decoded-out message and (b) transmit back to the portable device said decoded out message.

Independent claim 17 recites a method for operating a portable device including among other steps the step of storing into memory an image file having an open byte memory location and writing into the open byte memory location decoded-out message data.

Independent claim 22 recites a method for operating a portable device including among other steps the steps of storing into a memory an image file in an image file format, decoding a bar code represented in an image, converting decoded out message data into an image representation of decoded-out message data and stitching the image representation of the decoded-out message data into the image file.

Independent claim 30 recites a method for operating a portable device including among other steps the steps of actuating an image capture function a first time to capture a first image representation corresponding to a first view of a package, actuating an image capture function of the device a second time to capture a second image representation corresponding to a second view of the package, and associating the image representations with a decoded out message produced by decoding of a decodable symbol affixed to the package.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991), cited in MPEP §2143.

The Examiner has not established *prima facie* case of obviousness as to any claim.

Regarding claim 11, the Examiner, as best understood, alleges that col. 51, lines 46 - 60 of Wilz teach the limitations of claim 11. Wilz, column 51, line 46-60 reads as follows:

Notably, the remote unit 182 will embody at least one of the Internet access methods described in copending Application No. 08/846,219 filed Apr. 25, 1997; 08/869,164 filed June 4, 1997; and 08/916,694 filed Aug. 22, 1997. The method used by remote unit 182 (i.e., the Internet access terminal) will depend on the information that is encoded within the URL-encoded bar code symbol scanned by the bar code symbol reader 181. Optionally, a laser scanning bar code symbol scanning engine (without a digitizer or decoder) can be contained within hand-mounted unit 181, and the necessary digitizing and scan-data processing can be carried out by the microcomputing system within the remote unit 182 using techniques known in the art, or using special-purpose ASIC-type devices contained within remote unit 182 also known in the art. Wilz, column 51, lines 46-60.

While the Examiner has attempted to show a prior art bar code decoding system wherein image capture and decoding are carried out in separately housed structures, the Examiner makes no attempt to show that the prior art teaches numerous elements that are specifically recited in claim 11. In order to establish a case of *prima facie* obviousness, the Examiner must teach or suggest all claim limitations not just select claim limitations of a claim. Claim 11 specifically recites a control circuit sends to a spaced apart device an image along with a set of instructions instructing the spaced apart device to (a) decode a bar code symbol represented in said image to generate a decoded-out message and (b) transmit back to the portable device said decoded-out message. The Examiner at least does not show, and does not even attempt to show that Wilz teaches that a control circuit sends to a spaced apart device an image along with a set of instructions instructing the spaced apart device to (a) decode a bar code symbol represented in said image to generate a decoded-out message and (b) transmit back to the portable device said decoded-out message. Accordingly, the Examiner has not established a *prima facie* case of obviousness as to claim 11.

The Examiner also fails to consider all of the claim limitations of claim 17. For example, claim 17 recites among other steps the step of storing into memory an image file having an open byte memory location and writing into the open byte memory location decoded-out message data.

In attempting to demonstrate that Wilz teaches the elements of claim 17, the Examiner points to specific passages of Wilz. The Examiner apparantly alleges that certain passages of Wilz teach elements (a) (b) and (d) of claim 17. Notably however, the Examiner does not even allege that a section of Wilz teaches step (c) of claim 17 "writing the decoded-out message data...into the image file open byte memory location." The Examiner's inability to even identify text of Wilz which arguably satisfies the recitations of element (c) of claim 17 is taken as an admission by the Examiner that Wilz does not teach or suggest those recitations. The Examiner does not show and does not attempt to show that Wilz teaches the element of "writing the decoded-out message data...into the image file open byte memory location." At least because the Examiner has failed to even allege that Wilz teaches element (c) of claim 17, the Examiner has failed to establish a *prima facie* case of obviousness as to claim 17.

Regarding claim 22 the Examiner's rejection of claim 22 is presented as follows:

Re claims 17, 19-22, 24-26: Wilz, Sr. teaches a method for operating a portable device having a two-dimensional solid state image sensor, a memory, and being configured to decode a barcode in accordance with a decoding program, the hand held device being in communication with a separately housed spaced apart device, the method comprising the steps of:

- (a) storing into the memory an image file in a file format suitable for storing image files, the image file having an open byte memory location, the image file format having an associated file transfer protocol (col. 51, lines 19-45);
- (b) decoding a barcode (183 in fig. 8A) represented in an image utilizing the decoding program to produce decoded-out message data (col. 19, lines 24-37);
- (c) writing the decoded-out message data yielded by execution of decoding step (b) into the image file open byte memory location referred to in step (a); and
- (d) transmitting the image file including the decoded-out message data to the separately housed spaced apart device utilizing the file transfer protocol referred to in step (a) so that both of image data of the image file referred to in step (a) and the decoded out message data referred to in step (b) are transferred utilizing a single file transfer protocol (col. 51, lines 19-45; col. 63, lines 19-41).

However, claim 22 as originally presented is as follows:

22. (New) A method for operating a portable device having a two-dimensional solid state image sensor, a memory, and being configured to decode a bar code in accordance with a decoding program, said portable device being in communication with a separately housed spaced apart device, said method comprising the steps of:

- (a) storing into said memory an image file in a file format suitable for storing image files, said image file format having an associated file transfer protocol;
- (b) decoding a bar code represented in an image utilizing said decoding program to produce decoded-out message data;
- (c) converting said decoded-out message data into an image representation of said decoded-out message data;
- (d) stitching said image representation of said decoded out message data referred to in step (c) into said image file referred to in step (a); and
- (e) transmitting said image file to said separately housed spaced apart device utilizing said file transfer protocol referred to in step (a) so that both of original image data of said image file referred to in step (a) and said stitched-in image data corresponding to said decoded-out message referred to in step (d) are transferred utilizing a single file transfer protocol.

The Examiner's characterization of claim 22 and the applicant's actual claim 22 are presented side by side for comparison in Table 1.

Table 1

Examiner's Characterization Of Original Claim 22 in November 2, 2004 Office Action	Actual Original Claim 22
<p>A method for operating a portable device having a two-dimensional solid state image sensor, a memory, and being configured to decode a bar code in accordance with a decoding program, said hand held device being in communication with a separately housed spaced apart device, said method comprising the steps of:</p> <p>(a) storing into said memory an image file in a file format suitable for storing image files, said image file having an open byte memory location, said image file format having an associated file transfer protocol;</p> <p>(b) decoding a bar code represented in an image utilizing said decoding program to produce decoded-out message data;</p> <p>(c) writing said decoded-out message data yielded by execution of decoding step (b) into said image file open byte memory location referred to in step (a); and</p> <p>(d) transmitting said image file including said decoded-out message data to said separately housed spaced apart device utilizing said file transfer protocol referred to in step (a) so that both of image data of said image file referred to in step (a) and said decoded out message data referred to in step (b) are transferred utilizing a single file transfer protocol.</p>	<p>22. (New) A method for operating a portable device having a two-dimensional solid state image sensor, a memory, and being configured to decode a bar code in accordance with a decoding program, said portable device being in communication with a separately housed spaced apart device, said method comprising the steps of:</p> <p>(a) storing into said memory an image file in a file format suitable for storing image files, said image file format having an associated file transfer protocol;</p> <p>(b) decoding a bar code represented in an image utilizing said decoding program to produce decoded-out message data;</p> <p>(c) converting said decoded-out message data into an image representation of said decoded-out message data;</p> <p>(d) stitching said image representation of said decoded out message data referred to in step (c) into said image file referred to in step (a); and</p> <p>(e) transmitting said image file to said separately housed spaced apart device utilizing said file transfer protocol referred to in step (a) so that both of original image data of said image file referred to in step (a) and said stitched-in image data corresponding to said decoded-out message referred to in step (d) are transferred utilizing a single file transfer protocol.</p>

Comparing the elements of actual original claim 22 to the Examiner's characterization of original claim 22, applicant respectfully asserts that the rejection of claim 22 has been based on claim elements other than what was actually recited in claim 22. Specifically, the Examiner does not consider or attempt to consider at least the (c) converting and (d) stitching steps of claim 22. The not considered (c) and (d) elements remain in amended claim 22. The Examiner has failed to even allege that Wilz teaches or suggest all of the elements of claim 22. A plurality of claims *should never* be grouped together in a common rejection, unless that rejection is equally applicable to all claims in that group." (emphasis added). MPEP §707.07(d).

Regarding claim 30, claim 30 recites the combination of steps of actuating an image capture function a first time to capture a first image representation corresponding to a first view of a package, actuating an image capture function of the device a second time to capture a second image representation corresponding to a second view of the package, and associating the image representations with a decoded-out message produced by decoding of a decodable symbol affixed to the package.

While claim 30 recites the specific combination of steps of actuating an image capture function a first time to capture a first image representation corresponding to a first view of a package, actuating an image capture function of the device a second time to capture a second image representation corresponding to a second view of the package, and associating the image representations with a decoded out message produced by decoding of a decodable symbol affixed to the package, the Examiner does not show, and does not attempt to show that Wilz teaches the above combination of steps. In order to establish a case of *prima facie* obviousness the Examiner must demonstrate that the prior art teaches or suggests all of the element of the claims not just some of the elements.

In view of the above, applicant believes that independent claims 11, 17, 22, and 30 are allowable. Dependent claims 12-16, 18-21, 23-26, and 31-32 are believed to be allowable for

the reason that they depend on an allowable base claim and for the additional combinations of elements they recite.

Regarding the dependent claim rejections, applicant notes that there are numerous deficiencies with the rejections of the dependent claims. For example, regarding claims 12 and 13 reciting specific LED structures in combination with other elements, the Examiner does not even attempt to establish that Wilz teaches LEDs of an illumination assembly or that Wilz teaches or suggests white LEDs. Regarding claims 21 and 26 reciting wireless transmission features in combination with other elements, the Examiner does not attempt to establish that Wilz teaches wireless transmission in the combination claimed by the applicant. Regarding claim 15 reciting a portable device in a cellular phone form factor in combination with other elements, the Examiner points to a section of Wilz discussing a device (which does not appear to be the device cited in improperly rejecting the base claim) that is merely in communication with a cellular network. Regarding claim 18 reciting a .PDF image file format (i.e., Portable Document Format, developed by ADOBE) in combination with other elements, the Examiner points to a section of Wilz discussing the PDF (Portable Data File) type bar code symbol. The applicant's selective treatment of a subset of the dependent claims for purposes of generally demonstrating the inadequacy of the Examiner's rejections will not be taken as an admission that the applicant believes that the rejections of the claims not discussed are properly made.

The Examiner will note that the amendments to claims 17 and 22 actually broaden those claims. Accordingly, the claim amendments will not be considered "narrowing" claim amendments. Further, claim 15 is amended to include specific language of the specification (though cellular communications are supported at paragraph [0050]).

Applicant further respectfully requests that the Examiner of the present application coordinate with the Examiner of child Application No. 10/143,158 which has been made of record.

U. S. Patent Application No. 09/858,163
Amendment Dated February 2, 2005
Reply to Office Action Dated November 2, 2004

In order to aid the applicant in his effort to comply fully with his duty to disclose material information to the Office, the applicant requests that if an Examiner in one of the applications 09/858,163 or 10/143,158 cites an additional prior art reference, that the reference be made of record in the remaining application, and considered by the Examiner of the remaining application. Applicant is desirous of avoiding the situation where additional art references or bases for rejections are presented in a first of the above applications after close of prosecution on the merits in a second of the above applications.

Accordingly, in view of the above amendments and remarks, applicant believes all of the claims of the present application to be in condition for allowance and respectfully requests reconsideration and passage to allowance of the application.

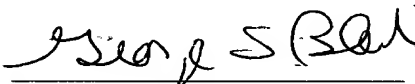
If the Examiner believes that contact with applicant's attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call applicant's representative at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

Respectfully submitted,

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